

DOCKET NO: 197792US-28

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
HIROAKI ISHIZUKA : EXAMINER: TRAN, H.
SERIAL NO: 09/725,511 :
FILED: NOVEMBER 30, 2000 : GROUP ART UNIT: 3694
FOR: METHOD AND SYSTEM OF :
ISSUING ELECTRONIC BILL :

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In reply to the Examiner's Answer of May 6, 2008, applicant provides the following
Reply Brief and comments.

Remarks begin on page 2 of this paper.

REMARKS

The Examiner's Answer of May 6, 2008 maintained the previous grounds for rejection and provided specific responses to the arguments set forth in Appellant's Appeal Brief. Those specific responses are now addressed.

Appellant previously argued the applied art to U.S. patent 6,055,573 to Gardenswartz et al. (herein "Gardenswartz") did not disclose or suggest the claimed feature of :

determining whether the customer is an acceptable credit risk for the on-line purchase using the customer's financial information in the supplier computer system and which is based on the off-line transaction[.]

In maintaining the rejection the Examiner's Answer states:

Gardenswartz teaches determining whether a value contract should be awarded to a customer based the customer's observed offline purchase history (see column 12, lines 65-67, figure 8/element 70; column 15, lines 19-40, figure 10/element 1000). Examiner interprets that the customer would not be offered a value contract if his purchase payment is not current and cited this in the Final Office Action (see pages 3-4, paragraphs 10-11, and pages 4-5, paragraph 14).¹

The above-noted basis for maintaining the rejection is improper. The noted "value contract" in Gardenswartz is nothing more than an in-store promotion for a consumer. Gardenswartz does not disclose or suggest that any determination of a credit risk of a customer is based on the noted off-line purchase history. Gardenswartz also does not disclose or suggest that the offering of the "value contract" is based on whether a purchaser is current on any payments. In fact Gardenswartz appears to disclose just the opposite. Gardenswartz specifically discloses information of the consumer's off-line purchase history for example can be obtained by a point of sale terminal using an optical scanner that scans a barcode, UPC code, or SKU on the purchased product (Gardenswartz at column 10, lines 38-

¹ Examiner's Answer of May 6, 2008, top of page 8.

45). Each of such ways of determining a customer's purchase history is unrelated to and would **not** result in any determination of whether a customer is an acceptable credit risk.

The outstanding rejection still has not pointed to any disclosure in any reference that would validate the interpretation that the "value contract" in Gardenswartz would only be offered if a purchaser was current on their payment.

For the above-noted reasons alone the outstanding rejection is improper and the above-noted claim features are clearly neither taught nor suggested by the relied upon art to Gardenswartz.

Moreover, as previously pointed out the claims as written are directed to determining whether the customer is an acceptable credit risk for an on-line purchase based on an earlier off-line transaction. The outstanding rejection appears to cite U.S. patent 6,092,053 to Boesch et al. (herein "Boesch") to disclose that consumer information can be stored on a server and provided for an on-line transaction.²

In reply to that grounds for the rejection, applicant notes the outstanding rejection has still not addressed the fact that Gardenswartz *teaches away* from such a combination with Boesch.

The "value contract" issued in Gardenswartz is directed to providing a consumer with a reward as an incentive for the consumer to visit a retail store, see again Gardenswartz at column 3, line 61 to column 4, line 12. Thereby, the objective of Gardenswartz is directly contrary to the noted objective in Boesch (of allowing an on-line transaction), and Appellant submits one of ordinary skill in the art would not have combined such teachings in the manner suggested in the rejection as they have contrary objectives. The outstanding rejection has not addressed such contrary objectives or such a teaching away in Gardenswartz from such a modification in any meaningful way. The Examiner's Answer merely points out both

² Examiner's Answer of May 6, 2008, page 4, prenumbered paragraph 5, and the paragraph bridging pages 8 and 9.

Gardenswartz and Boesch are directed to electronic commerce and within the general knowledge of one ordinary skill in the art.³

Those conclusory statements in the Examiner's Answer, however, do not address the actual way Gardenswartz and Boesch are being combined. Gardenswartz is being combined specifically for the teaching of the "value contract", which is provided to a consumer so that a consumer will visit a retail store. The teachings in Boesch of allowing a consumer to purchase data on-line is unrelated to issuing of such a "value contract" in Gardenswartz; the issuing the "value contract" in Gardenswartz being a critical basis for the rejection. Disregarding the objective of Gardenswartz to issue such a "value contract" in the combination with Boesch is contrary to the disclosures in the references themselves, and thus Appellant submits would not have been suggested to one of ordinary skill in the art.

Dependent Claims 2 and 5

With respect to dependent claims 2 and 25 the Examiner's Answer states "Examiner notes that Gardenswartz could have been easily modified to include a 'lease' in its invention and that a combination of both Gardenswartz and Boesch would disclose an off-line transaction of a lease".⁴

The above-noted basis for maintaining the rejection of dependent claims 2 and 25 is believed to be clearly improper as simply the noted "value contract" in Gardenswartz is not directed to and does not suggest an off-line transaction of a lease. It is also not at all clear on what basis Gardenswartz could have been easily modified to include a lease.

³ Examiner's Answer of May 6, 2008, middle of page 9.

⁴ Examiner's Answer of May 6, 2008, the sentence bridging pages 9 and 10.

Dependent Claims 3-5 and 26-28

The outstanding rejection has dismissed the features recited in claims 3-5 and 26-28 by stating "Examiner interprets that the customer's off-line purchase history [in Gardenswartz] would have included a purchase of an image forming device as such device is so popular in today's computer world".⁵

The above-noted grounds for the rejection is believed to be clearly improper as again in the claimed invention the lease or purchases of an image forming device, copier, or facsimile machine from an off-line transaction can be subsequently used for an on-line purchase, which is neither taught nor suggested by Gardenswartz.

Dependent Claims 6, 7, 29, and 30

Gardenswartz does not disclose or suggest any determination of a customer being an acceptable credit lease as discussed above in detail, and the "value contract" cited in Gardenswartz is completely unrelated to determining whether a customer would be an acceptable credit risk based on a lease of a machine, and further based on up-to-payments on the lease. The Appellant again points out Gardenswartz does not provide any disclosure or suggestion that the "value contract" would be issued based on the lease or up-to-date payments on the lease.

Dependent Claims 8-15, 20-21, 31-38, and 43-44

The Examiner's Answer now references U.S. patent 5,826,241 to Stein et al. (herein "Stein") with respect to positions for which Official Notice was taken. However, the Examiner's Answer has not addressed the fact that Gardenswartz teaches away from such features as Gardenswartz is specifically only directed to issuing a "value contract" to a customer, but is not at all related to any billing aspects. As Gardenswartz teaches away from

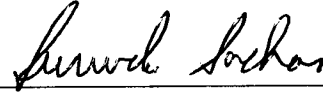
⁵ Examiner's Answer of May 6, 2008, middle of page 10.

such a combination, one of ordinary skill in the art clearly would not have combined any of the noted teachings in Stein with Gardenswartz to meet the features recited in the further above-noted dependent claims.

In view of the present comments, and the comments presented in the Appeal Brief filed April 3, 2008 applicant respectfully submits the outstanding rejections are improper and must be REVERSED, and thereby each of claims 1-46 is allowable over the previously applied art.

Respectfully submitted,

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